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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,254	06/15/2001	Hugh Boyd Morrison	RCA 89185	6997

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EXAMINER

BROWN, RUEBEN M

ART UNIT PAPER NUMBER

2623

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,254

Applicant(s)

MORRISON ET AL.

Examiner

Reuben M. Brown

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7/20/2006 have been fully considered but they are not persuasive. Applicant argues on page 8, 'Thus, the block with the wording FREE SHOWTIME FOR DECEMBER is not received while the user is checking email'. However, examiner points out that no such requirement is recited in the claims. Claim 1 states, "receiving, while said computer application software program is running". Examiner interprets the EPG in Schein to read on the claimed "computer application software program". Therefore at any point that the advertisement the advertisement in block 524 is received, would meet the limitation in question.

Furthermore, even if the claimed feature of, "computer application software program" was more narrowly limited to the e-mail mode of the EPG, it is pointed out that col. 22, lines 12-15, of Schein cites that "For example, a scrolling commercial message 524 may be located underneath program matrix 506 that advertises programs or products from program sponsors". Thus, it is clear that the actual advertisement displayed in block 524 is not static, but rather is dynamic and may change.

Moreover, examiner directs applicant to MPEP 2106, section 6:

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a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material. Since Schein clearly teaches the display of scrolling advertisement in block 524, the display of this advertisement at a particular time represents non-functional descriptive material.

Applicant also argues that Schein does not disclose the limitation “operating said video processing apparatus in said video operating mode in response to said selecting said advertisement”. However, Schein teaches “the viewer may navigate to message 524 to receive more information or to purchase the product or program’, col. 22, lines 15-18. Thus Schein enables the user to access the video program after selecting an advertisement of the instant video program, which reads on the claimed subject matter.

Applicant also argues that Schein only discloses a single mode, whereas “in claim 1, the term ‘mode’ may refer to operation in a video operating mode, wherein video may be displayed, or to another mode such that as a mode in which computer application software is running”. Examiner agrees that ‘mode’ may be interpreted as such, but also points out that the term, ‘mode’ is broad enough to read on any of the different presentation formats, as shown in Schein. For instance, 16a, Fig. 19a, 19b, 20b, all read on a separate modes, since in each example the user is directed to accessing different services. Therefore, the claimed feature of “operating the apparatus in at least one other mode”, is broad enough to read on a TV program on a screen without any EPG, as shown in Fig. 16a, or the TV screen showing any number of different service available from different EPG menu screens. See Schein, col. 21, lines 19-65, which specifically refers to the different features of the EPG as modes, in a mode menu area 512 and allows the user to access a mode menu 514.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2 & 5-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Schein, (U.S. Pat # 6,002,394).

Considering claim 1, the claimed method for operating a video processing apparatus, such that the video processing apparatus operates in a video—operating mode and in at least one other mode, and wherein the video processing apparatus has an EPG operable in the video operating mode, is met by the disclosure of Schein, Fig. 16A. ‘Operating the video processing apparatus in at least one other mode’, is met by the mode wherein messages and other services may be access, see Fig. 19B-20C; col. 6, lines 50-65. The feature of the ‘video processing apparatus operating a computer application software that is capable of receiving messages’ is met by the disclosure of Schein Fig. 19B-19C. The claimed ‘computer software application is met by the EPG, disclosed in Schein, which Schein teaches enables the user access a variety of modes, via mode menu 514, col. 21, lines 19-65.

Receiving an advertisement while the computer software application is running’ is met by Fig. 19B-19C, which shows that a scrolling advertisement may be received at any pint by the EPG, including during the e-mail mode. ‘Causing the advertisement to be displayed by the computer application software’, is met by the user in Schein navigating to select the advertisement 524 receive more information, col. 22, lines 12-18.

‘operating the video processing apparatus in eth video operating mode to obtaining the TV program related to the advertisement’ is met by the user in Schein, using the EPG to select the video program, col. 21, lines 25-50 & col. 22, lines 15-65.

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Considering claims 2 & 8-9, the functionality of the EPG, in the PCTV of Schein meets the claimed subject matter.

Considering claim 5, Schein teaches that the user system may be connected to a VCR device, see Fig. 1.

Considering claim 6-7, the claimed method steps for operating a video processing apparatus comprising steps that correspond with subject matter mentioned above on the rejection of claim 1, are likewise treated.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-4 rejected under 35 U.S.C. 103(a) as being unpatentable over Schein.

Considering claims 3-4, Schein does not discuss any control data associated with the advertisement. Official Notice is taken that at the time the invention was made, it was well known to include channel, start time, and dates in an ad for a TV program so the user is aware of the tuning information. It would have been obvious for one of ordinary skill in the art at the time the

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invention was made, to modify Schein with the known feature of including tuning information in an ad, at least so that the user is able to select the advertised program when it is broadcast.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) LaJoie Teaches that a viewer may receive an ad concerning an event different from the current TV program, after which the viewer may select the icon for tuning to the event, col. 11, line 50-65 thru col. 12, lines 1-28.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:


(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown


HAT TRAN
PRIMARY EXAMINER